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Examiner has rejected the claims on one ground only, on the merits over prior art comprising a single reference. In response, they have amended their claims to more clearly distinguish over the prior art, and have added supported claims including the distinguishing language to provide well-rounded protection for their invention.

Reconsideration of the rejection and allowance by the Examiner are respectfully requested.

In accordance with the Applicants' development, labels having a permanent section and at least one removable coupon section are made from polymeric film sheets or rolls suitable for printing and forming, at high rates of production, blown or injection in-mold labeled plastic containers;

(i) if the films are oriented mono-axially in line with the direction of tear when the coupon is ultimately removed. (Specification, page 5, lines 31-32, page 7, lines 17-19, page 9, lines 22-25 and page 11, lines 18-21); preferably, (ii) if an adhesive layer is provided on the back side of the coupon portion and the entire back side of the label is overcoated with a continuous adhesive layer. (Specification, page 7, lines 8-13); and, especially preferably, (iii) if there are selected and used oriented polymeric films having a coefficient of thermal expansion/contraction substantially the same as that of the plastic containers to be in-mold labeled. (Specification, page 9, line 25, to page 10, line 7).

Claims 1-6, 14, 16, 31 and 32 call for the preferred features of aspect (i).

Claims 7-13, 15, 17, 33 and 34 call for the preferred features of aspects (i) and (ii), combined.

Claims 18-30 call for the preferred features of aspects (i), (ii), and (iii), combined.

In the Office Action, pages 2 and 3, paragraph number 2, claims 1-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al., U.S Patent No. 5,409,754. The rejection is deemed to apply to newly added claims 18-34, as well.

Reconsideration of the rejection is requested.

The following quotations are the Examiner's grounds for making the obviousness rejections set forth in the Office Action:

"Yasuda et al. disclose an in-mold label/ article of manufacture with a coupon comprising at least one removable section (5- coupon which, inherently, receives printing) and at least one permanent section (sections located on the opposite surfaces of the adhesive 3 in figure 1), the removable section being defined by two or more discontinuities (6) spaced apart on an edge of the label."

"Yasuda et al. disclose the claimed invention except for the particular material of the label as claimed (claims 1-17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any type of material (i.e. polymeric film that is uniaxially oriented, opaque or clear virgin olefin homopolymer, etc.) as necessitated by the end user, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416. Regarding claims 2 and 8, it would have been an obvious matter of design choice to provide the label with any desired dimensions, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art, *In re Rose*, 105 USPQ 237 (CCPA 1955)."

The Applicants have carefully studied Yasuda et al and point out that Yasuda et al disclose a biaxially oriented sheet, an adhesive layer under the coupon, deadened with a patterned silicone layer and a perforated border around the edges of the coupon to facilitate coupon removal.

In contrast, the label called for by claims 1-17 of the Applicants' invention, as filed, uses a monoaxially-oriented film (required by all of claims 1-34), an abhesive layer under the coupons (required by all of claims 7, 8, 15, 17, 24, 25, 33 and 34) which do not require scoring and/or perforations, thereby obtaining an easily removable coupon free of wrinkling, creasing and blistering. In addition, as has been explained above new claims 18-34 include the distinguishing language, and all call for substantially the same coefficient of thermal expansion/contraction.

In contrast, the entire tenor of the Yasuda et al reference is to select and use a biaxially-oriented film. Yasuda et al's base layer comprises a biaxially stretched film, (Abstract), prepared by first stretching in the machine direction then stretching in the transverse direction (Yasuda et al's Specification, Col. 5, lines 10-23).

Yasuda et al suggest, in passing, that where base layer 2 is a composite film, it can comprise a biaxially stretched core layer and a uniaxially stretched paper layer, without however teaching the orientation of the latter, ie., machine direction or transverse direction.

By this Amendment, all of the instant claims now call for stretching in one direction only, thereby clearly excluding Yasuda et al's teachings to stretch in two directions.

Furthermore, Yasuda, et al, go on to state, with reference to Figures 1 and 2:

``As previously explained, adhesive layer 3 is not formed on the entire back side of base layer 2. That is, it is applied to the part except less adhesive zone 4 where

adhesive layer 3a is formed at a density of not more than 50%." (Col. 5, lines 52-56); and

"Alternatively, the adhesive layer comprising adhesive layer 3b partitioned by less adhesive layer 3a can be formed by applying an adhesive layer on the entire back side of base layer 2 by extrusion and applying a parting agent, such as a silicone resin, in a dot form, a stripe form, a check form, etc, to the adhesive layer corresponding to coupon 5" (Col. 6, lines 20-26).

As the Applicants herein and their disclosure explain, it is critical to the present invention that the adhesive layer is always put down before a continuous layer of adhesive is put down overall. This results in a structure unlike Yasuda et al's Figure 1 and 2, in which the 3b's are interrupted by 3a, rendering the adhesive layer discontinuous. Thus claims 7, 24, 33 and 34 and their dependents are patentable over Yasuda for the further reason that they define a structural difference and not only differ merely by the particular material used or the measurements thereof.

The rejection over Yasuda et al should be reconsidered and withdrawn because the language of the claims as amended calls for features which could not have involved a mere matter of obvious design choice.

In the Office Action, the prior art made of record and not relied upon was considered pertinent to the Applicants' disclosure. The Applicants point out that Volkman (U.S. 5,238,720) discloses a molded-in label with removable portion, that Dronzek, Jr. (U.S. 5,711,839) discloses a process for the production of in-line gravure-printed in-mold labeled blow molded containers, that Clopay Corporation (WO 92/07347) disclose scored synthetic in-mold labels and molded substrates labeled therewith and that Oji Yuka Goseishi Co., LTD. (EPO 0587178) disclose in-mold

labels with coupons. The Applicants further note that even in combination with Yasuda et al, there is no teaching that the label films must be uniaxially oriented by stretching in one direction only.

Claims 1-34 should now be allowed.

Early and favorable action is earnestly requested.

Respectfully submitted



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MARKED UP COPY OF THE CLAIMS

1. (amended) A label having at least one tear-removable section and at least one permanent section, said removable section being defined by two or more discontinuities spaced apart on an edge of said label, said label being made from (a polymeric film that is uniaxially oriented in line with the direction of tear by stretching in [the machine] one direction only) and said discontinuities being located so that a line which is extended to connect said discontinuities is substantially perpendicular to the axis of orientation of said polymeric film.

7. (amended) A label having at least one tear-removable section and at least one permanent section, said removable section being defined by two or more discontinuities spaced apart on an edge of said label, said label being made from (a polymeric film that is uniaxially oriented in line with the direction of tear by stretching in [the machine] one direction only) and said discontinuities being located so that a line which is extended to connect said discontinuities is substantially perpendicular to the axis of orientation of said polymeric film;

wherein a print-receiving face of said polymeric film includes at least one print enhancing surface to enhance the anchorage of ink, said print enhancing surface comprising a primer, a product of flame-treatment, corona-treatment or chemical treatment, a coextruded print receiving layer or a combination of any of the foregoing layers;

wherein said permanent and the removable sections are provided with a continuous adhesive layer for anchoring the permanent section to a surface; and

wherein the removable section is provided first with a removable-section-defining adhesive layer for stripping the removable section from a surface.